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09/017,959	02/03/98	BERNHARDT	8117-000021

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EXAMINER

PIERCE, W

ART UNIT PAPER NUMBER

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UNITED STATES DEPARTMENT OF COMMERCE
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 12

Application Number: 09/017959
Filing Date: 2/3/98
Appellant(s): Bernhardt

Duke Taylor
For Appellant

MAILED

AUG 10 1999

GROUP 3700

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 6/8/99.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

Art Unit:

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: In addition to the rejection of claims 1-16 under 102(b) over Stevens, claims 1-16 remain further rejected under 35 USC 112, second paragraph as set forth in paper No. 7.

Art Unit:

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-5 and claims 6-16 stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

D97360

Stevens

10-1935

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-16 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention as set forth in prior Office action, Paper No. 7.

Art Unit:

Claims 1-16 are rejected under 35 U.S.C. 102(b). This rejection is set forth in prior Office action, Paper No. 7.

(11) Response to Argument

Appellant's first four paragraphs providing a summary of his invention and subsequent two paragraph restating the grounds for rejection are noted.

Appellant takes exception to the fact that the applied reference is a design patent and that it has no specification. While he fails to state any authority as to why this issue is important, it appears that appellant finds this important since it does not mention using shown apparatus in Stevens with a bowling ball.

From this he concludes that the reference is not analogous to the art. However, it is clearly stated in MPEP 2131.05 that "arguments that the alleged anticipatory prior art is 'nonanalogous art'...is not 'germane' to a rejection under section 102". See *Twin Disc, Inc. V United States*, 231, USPQ 417, 424 (Cl. Ct. 1986)(Quoting *In re Self*, 617F.2d1344, 213 USPQ 1, 7 (CCPA 1982).

While appellant's subsequent remarks applying a "two part test" are not considered "germane", they will be addressed briefly. First it is alleged that the apparatus of Stevens is not in the same field of the endeavor since it fails to mention bowling. Examiner cannot agree since the field or endeavor is one of finger cots or devices that slip over the tip of the finger. Such devices in this field are both as tools or protectors.

Art Unit:

Appellant goes on to state that the reference is not pertinent to the problem that the inventor is involved. Such is not true since one concerned with protecting the finger and gripping would consider the structure of all types of finger cots regardless of their intended use.

In response to applicant's argument that the applied hindsight, the rejection does not rely on a judgement of obviousness to which hindsight applies. Since the examiner's conclusion was not one of obviousness but one of anticipation, this argument is also not considered to be germane.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


WILLIAM M. PIERCE
PRIMARY EXAMINER

wp
August 16, 1999